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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,811

11/16/2007

Richard Spitz

10191/4496

8036

26646

7590

10/29/2009

KENYON & KENYON LLP
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EXAMINER

PHAM, EMILY P

ART UNIT

PAPER NUMBER

2838

MAIL DATE

DELIVERY MODE

10/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,811	Applicant(s) SPITZ ET AL.	
	Examiner Emily Pham	Art Unit 2838	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/30/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/30/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 01/30/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

3. Fig. 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Shiga et al (USP 4,529,667).

Regarding independent claim 9: AAPA (**FIG 1, par [0003] – par [0006]**) discloses a press-fit diode **(1)**, comprising a diode chip **(7)**; a base contact **(3)** for pressing the press-fit diode **(1)** into a substrate, wherein the base contact **(3)** is attached to the diode chip **(7)** and forms a first terminal of the press-fit diode **(1)**; and a wire contact **(2, 4)** which forms a second terminal of the press-fit diode **(1)**, wherein the wire contact **(2, 4)** is attached to the diode chip **(7)**.

AAPA, however, does not disclose the wire contact is at least partially provided with a silver layer.

Shiga et al (**whole document**) teaches it is well known in the art to have the wire contact at least partially provided with a silver layer (**Abstract, lines 12-52 of col. 1**).

Since AAPA and Shiga et al are from the same field of endeavor, the purpose taught by Shiga et al would have been recognized in the pertinent arts of AAPA. Therefore, it would have been obvious to a person having ordinary skill in

Art Unit: 2838

the art at the time the invention was made to utilize the silver coated electric composite materials to manufacture the press-fit diode of AAPA, as taught by Shiga et al, for the purpose of providing necessary soldering characteristics to guarantee the successful manufacturing of the diode (**Shiga et al, lines 8-11 of col. 1; lines 5-64 of col. 6**).

Regarding claim 10: AAPA (**FIG 1, par [0003] – par [0006]**) discloses a section of the wire contact attached to the diode chip is not provided with the silver layer.

Regarding claim 11: AAPA (**FIG 1, par [0003] – par [0006]**) discloses the base contact is not provided with a silver layer.

Regarding claim 12: Shiga et al (**whole document**) teaches the wire contact further includes a nickel layer on which the silver layer is applied (**Abstract, lines 19-30 of col. 2**).

Regarding claims 13-18: AAPA in view of Shiga et al (**see the rejection of claims 9-12**) disclose the apparatus that is manufactured by the method disclosed in claims 13-18.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Spitz et al (USP 6,060,776) discloses rectifier diode and Torti et al (USP 6,559,529) discloses press-fit diode for universal mounting.

Art Unit: 2838

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Pham whose telephone number is (571)270-3046. The examiner can normally be reached on Mon-Thu (7:00AM - 6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Lewis can be reached on (571) 272 - 1838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jessica Han/
Primary Examiner, Art Unit 2838
October 2009

EP